



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/762,187

01/21/2004

James Kenneth Taillon

0214.007C

3673

7590 02/12/2008  
Brett M. Hutton, Esq.  
Heslin Rothenberg Farley & Mesiti P.C.  
5 Columbia Circle  
Albany, NY 12203

EXAMINER

PRASAD, CHANDRIKA

ART UNIT

PAPER NUMBER

2839

MAIL DATE

DELIVERY MODE

02/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/762,187	<b>Applicant(s)</b> TAILLON ET AL.	
	<b>Examiner</b> CHANDRIKA PRASAD	<b>Art Unit</b> 2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4,9-16,19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,9-16,19,21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Reissue Applications***

1. The amendments filed 11/14/07 is acknowledged.
2. Claims 22-28 are objected to under 37 CFR 1.173(d)(2) as being in improper form because they are not underlined.
3. Claims 2-4, 9-16, 19 and 21-28 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

This reissue application purports to be a narrowing reissue application but it is not. The new claims in the reissue application are broadening reissue claims under MPEP section 1412.03 (I) which makes this a broadening reissue which would have needed to be filed within 2 years of the issue date of the patent (see 35 USC 251 and MPEP section 1412.03 (IV)) and would have required a declaration signed by the inventors (see MPEP section 1412.03(V)).

After the Claims 1, 5-8, 17-18 and 20 of the Patent 5,573,414 have been disclaimed; the broadest claims in the patent 5,573,414 are 2, 11, 14 and 21. Thus, the applicant is not entitled in the reissue application to include any claims broader than these claims (2, 11, 14 and 21) in the patent. The new independent claim 28 basically contains the limitations of patent claim 2; however, the patent claim 2 states that the step of removing takes place prior to the securing step. Claim 28 does not limit the removing step to occur before the securing step. Thus, the new claim 28 is broader than patent claim 2. Similarly, Claims 22-24 are broader than claim 9.

Furthermore, Claim 22 is broader than Claim 1 of the Patent 5,573,414. Claim 1 of the Patent 5,573,414 requires matably connecting the first and second members (the sleeve and the clip in Claim 22) to form a hollow inner chamber. Claim 22 of the reissue application does not

require such a limitation. Thus, the new claim 22 in the reissue application is broader than Claim 1, which is a part of the original patent and a part of the later-disclaimed claims.

Such instances are not necessarily all inclusive. Unless the claims are copied exactly, it is very difficult to avoid improper broadening outside the 2 year period set forth in 35 USC 251.

A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

The standard for broadening if a claim is broadening is if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.

#### ***Response to Arguments***

4. Applicant's arguments filed 11/14/07 have been fully considered but they are not persuasive. One can not broaden the claims beyond the scope of protection afforded by the original patent claims. In the instant application, a statutory disclaimer was filed on June 10, 2004 canceling certain claims. A statutory disclaimer under 35 USC Section 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent, See Vectra Fitness Inc. v. TNWK Corp., 49 USPQ2d 1144 (Fed. Cir. 1998).

Therefore, in the instant application, it is proper to consider the broadening question with respect to claims remaining after the disclaimer. Furthermore, the claims in the reissue application are broader than the original claims in the patent and the claims before filing of the disclaimed. As described earlier in Paragraph 2 above, the new claims in the reissue application are broadening reissue claims.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

6. Any correspondence to this action may be mailed to:

**Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad at (571) 272-2099.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (571) 272-2800 ext 39. The fax number is (703) 872-9306.

/Chandrika Prasad/  
Primary Examiner, Art Unit 2839  
February 5, 2008